

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-4, 9-16, 18-21, 28-30, 32, 34, 44 and 47-52 are all the claims pending in the application.

Applicant hereby respectfully traverses all the rejections.

Information Disclosure Statement (IDS)

Applicant thanks the Examiner for initialing the references listed on the IDS submissions filed on April 30, 2004.

However, with respect to two¹ references listed in the IDS submission filed on April 12, 2001, the Examiner continues to assert that “there was not a brief description/translation submitted” (See Office Action: page 2). Applicant respectfully disagrees.

Pertinent portion of the MPEP states the following:

[t]he concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. (MPEP § 609.04(a) III.).

At the time of filing the IDS submission on April 12, 2001, Applicant stated that the two references being submitted are discussed within the Specification beginning at page 8, lines 4-5. As the relevance of two references are clearly stated in the pointed section of Applicant’s Specification, Applicant respectfully submits that the concise explanation requirement under 37

¹ Japanese Laid-Open Patent Application No. 63-13226, published March 24, 1988 and Japanese Laid-Open Patent Application No. 4-33065, published February 4, 1992.

C.F.R. § 1.98 (a)(3) is fully met. Therefore, Applicant respectfully requests that the Examiner consider the references cited in the IDS submission filed on April 12, 2001.

Declaration under 37 C.F.R. § 1.132

With respect to the declaration submitted under 37 C.F.R. § 1.132 on April 28, 2006, the Examiner states that the declaration is deficient, as the “[a]pplicant has not stated that the work was commonly owned under an obligation of assignment at the time of filing” (See Office Action: page 8). Applicant respectfully disagrees.

The previously cited secondary reference Uchida (U.S Patent No. 6,751,734) has a common inventor² with the instant application, and the filed declaration attests to such. Based upon the earlier effective U.S. filing date of the reference, Uchida constitutes prior art under 35 U.S.C. §. 103 (a)/102(e). However, rejections under 35 U.S.C. § 102(e) may be overcome by a showing under 37 CFR § 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another" (See MPEP §§ 706.02 (b) and 2136.05).

In view of the foregoing, Applicant respectfully requests the Examiner to withdraw the rejections on claims 9-12, 28, 29 and 30 based in part on Uchida (U.S Patent No. 6,751,734).

² That is, Applicant respectfully points out that the previously cited prior art reference Uchida (U.S Patent No. 6,751,734) was invented by the same sole inventor of the current application. That is, as stated in the submitted declaration, Mr. Kaoru Uchida is the sole inventor for both U.S Patent No. 6,751,734 and current application. Therefore, Applicant respectfully notes that the Examiner’s characterization of the current application that “[t]his application currently names joint inventors” is erroneous (See Office Action: page 2).

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 14-16, 18-21, 32, 34, 44, and 47-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Till et al. (U.S. Patent No. 6,404,337; "Van Till") in view of Danielson et al. (U.S. Patent Application No. 2003/0081860; "Danielson").

Claim 1 recites, *inter alia*, "extracting first *biometrics data* submitted by a person who is to receive the delivered article..." The Examiner asserts that the "digital signature" described in the primary reference Van Till teaches the noted "first biometrics data" recited in claim 1 (See Office Action: page 3). Applicant respectfully disagrees.

There is no extraction of "biometrics data" described in Van Till. Van Till generally describes a system which enables a customer to provide a digital signature at times when the customer is not present to physically sign for a parcel (See Van Till: col. 3, lines 54-56).

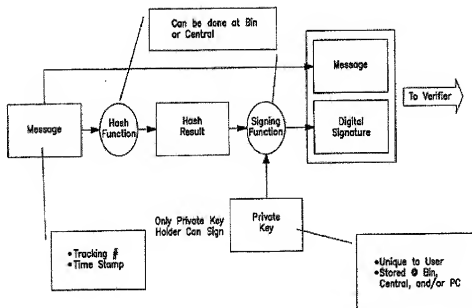


FIG. 2

However, as shown above in Fig. 2 of Van Till, the digital signature is created with a hash result of the message and the private key inputted into the signing function. Van Till plainly states that such signing function “may use a private key to create the digital signature” (See Van Till: col. 5, lines 4-5). As such, the digital signature described in Van Till merely pertains to encrypted code which is associated with the customer. However, such digital signature does not pertain to a literal hand signature of the customer. Such is made apparent by the electronic “verification” process which the digital signature undergoes (See Van Till: col. 5, lines 9-18, lines 57-66). Therefore, Applicant respectfully submits that the digital signature described in Van Till altogether fails to teach or suggest the claimed “biometrics data.”

Further, Van Till fails to teach or suggest “extracting first biometrics data ... *at a time of ordering*,” as recited in claim 1. That is, there is no disclosure in Van Till that the digital signature is extracted “at a time of ordering.” If anything, Van Till seems to suggest the contrary, as it plainly states “once an item is delivered [emphasis added] to an unattended storage device (or storage bin), the storage device creates a message, which may include the tracking number for the item and a time stamp” (See Van Till: col. 4, lines 60-64). Therefore, Applicant respectfully submits that the “digital signature” is created upon *delivery* of the ordered item at the storage device, rather than “at a time of ordering,” as recited in the claim 1.

Furthermore, Van Till fails to teach or suggest “extracting *second* biometrics data submitted by the recipient at a time of delivery,” as recited in claim 1. That is, Van Till only describes a *single* generation of a digital signature (See Van Till: col. 4, lines 58 - col. 5, line 18).

There is simply no description of a subsequent generation or extraction of digital signature in Van Till.

In view of all the foregoing, Applicant respectfully submits that claim 1 is patentable over Van Till in view of Danielson. Applicant respectfully submits that Danielson³ fails to make up for the above noted deficiencies of Van Till.

With respect to independent claims⁴ 2-4, 14-16, 32, 44 and 47-52, Applicant respectfully submits that the claims are patentable under the rationale analogous to those discussed with respect to claim 1. Further, Applicant respectfully submits that claims 18-21 and 34 are patentable by virtue of their dependency.

Claims 9-13 and 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over VanTill and Danielson and further in view of Berson (U.S Patent No. 6,802,005; "Berson"). Applicant respectfully submits that Berson is merely being cited for allegedly teaching "the use of a thumbprint scanner," and as such, fails to make up for the noted deficiencies of Van Till and Danielson discussed above. Therefore, Applicant respectfully submits that claims 9-13 and 28-30 are patentable over Van Till in view of Danielson and Berson under the rationale analogous to those discussed with claim 1.

³ That is, e.g., Danielson at least fails to teach or suggest that the capturing of signatures take place "*at a time of ordering*," as recited in claim 1. Danielson lacks any description that the captured signatures bear any relation to a particular delivery order made at the time of ordering (See Danielson: paragraph [0069]-[0071]).

⁴ Noted features of claim 1 are similarly recited in each of the independent claims.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/832,826

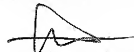
Attorney Docket No.: Q64083

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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23373

CUSTOMER NUMBER

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